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PTO/SB/21 (09-06)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/825,537	Confirmation No.: 9788
Filing Date	April 2, 2001	
First Named Inventor	Masood Garahi	
Art Unit	3628	
Examiner Name	Nga B. Nguyen	
Total Number of Pages in This Submission		Attorney Docket Number ODS-25

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input checked="" type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	- Exhibits A-C; and
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	- Return postcard.
	<input type="checkbox"/> Landscape Table on CD	

Remarks

The Director is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.16, in connection with the paper(s) transmitted herewith, or credit any overpayment of same, to Deposit Account No. 06-1075, Order No. 003043/0025. A duplicate copy of this Transmittal Form is transmitted herewith.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	FISH & NEAVE IP GROUP / ROPES & GRAY LLP		
Signature			
Printed name	James A. Leiz		
Date	July 2, 2007	Reg. No.	46,109

CERTIFICATE OF TRANSMISSION/EXPRESS MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as EXPRESS MAIL (Express Mailing Label No. EM015926780US) in an envelope addressed to: Mail Stop PETITION Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Andrew Shive	Date	July 2, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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ODS-25

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants : Masood Garahi et al.
Application No. : 09/825,537 Confirmation No. : 9788
Filed : April 2, 2001
For : SYSTEMS AND METHODS FOR PLACING
PARIMUTUEL WAGERS ON FUTURE EVENTS
Art Unit : 3628
Examiner : Nga B. Nguyen

New York, New York 10020

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

July 2, 2007

PETITION UNDER 37 C.F.R. § 1.181(a)
TO WITHDRAW HOLDING OF ABANDONMENT

Applicants hereby petition under

37 C.F.R. § 1.181(a) to withdraw the holding of Abandonment
set forth in the Notice of Abandonment dated May 18, 2007
(copy attached as Exhibit A). Pursuant to
37 C.F.R. § 1.181(f) and MPEP § 711.03(c)(I)(C), this
Petition is being timely filed within two months of the
mailing date of the Notice of Abandonment (i.e., on or
before July 18, 2007).

Statement of Facts

On February 2, 2007, a Notice of Panel Decision from Pre-Appeal Brief Review was mailed by the United States Patent and Trademark Office ("USPTO") (copy attached as Exhibit B) in response to the Pre-Appeal Brief Request for Review filed on September 1, 2006 (copy attached as Exhibit C). The Notice of Panel Decision states that the appeal has proceeded to the Board of Patent Appeals and Interferences, and that "The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater."

Because the one month date from the mailing of the Notice of Panel Decision is greater, this sets the deadline for filing the appeal brief to be March 2, 2007. The Notice of Panel Decision continues: "Further, the time period for filing of the appeal brief is extendable under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable." Thus, applicants have a final deadline, including five months of extension, of August 2, 2007 for filing the appeal brief, and submit that the Notice of Abandonment (see Exhibit A) mailed by the Examiner is in error.

The undersigned held telephone interviews with Examiner Nguyen on June 11, 2007 and July 2, 2007. During the June 11, 2007 telephone interview, the Examiner agreed that the Notice of Abandonment was sent in error and that she would proceed to withdraw the Notice of Abandonment without requiring applicants to file this Petition. During the July 2, 2007 telephone interview, the undersigned inquired whether the Examiner withdrew the holding of abandonment. The Examiner stated that she would only withdraw the holding of abandonment when the appeal brief is received and she recommended filing this Petition.

Conclusion

Based on the foregoing, applicants respectfully request that the USPTO grant this Petition to withdraw the holding of abandonment.

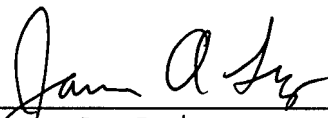
Applicants are submitting concurrently an appeal brief under 37 CFR 41.37 to the Board of Patent Appeals and Interferences. Applicants respectfully request that the appeal brief be entered in the above-identified patent application.

Pursuant to MPEP § 711.03(c)(I)(B), no fee is due in connection with this Petition. Should any fees be due, however, the Director is hereby authorized to charge any

fee that may be due in connection with this Petition or resubmission of the Reply to Deposit Account 06-1075. A Fee Transmittal (Form PTO/SB/17) is enclosed herewith for this purpose.

An early and favorable action is respectfully requested.

Respectfully submitted,



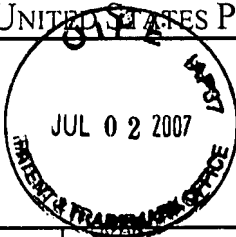
James A. Leiz
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EXHIBIT A:
NOTICE OF ABANDONMENT MAILED MAY 18, 2007



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/825,537

04/02/2001

Masood Garahi

ODS/025

9788

1473 7590 05/18/2007
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ROPES & GRAY LLP
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NEW YORK, NY 10036-8704

RECEIVED

MAY 23 2007

ROPES & GRAY LLP, PATENT DEPT.
REFERRED TO JUL 16 1450
NOTED BY MSB

EXAMINER

NGUYEN, NGA B

ART UNIT PAPER NUMBER

3692

MAIL DATE DELIVERY MODE

05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

File No.: ODS/025
Action Desc: Let. to Rev. 11/10/07
Due Date: June 18, 2007
By: [Signature]



Notice of Abandonment

Application No.

09/825,537

Examiner

Nga B. Nguyen

Applicant(s)

GARAH ET AL.

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 02 February 2007.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

Nga Nguyen

NGA NGUYEN
PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

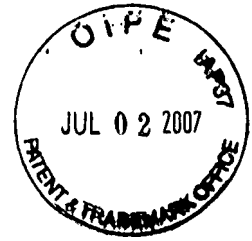



EXHIBIT B:
NOTICE OF PANEL DECISION FROM PRE-APPEAL
BRIEF FOR REVIEW MAILED ON FEBRUARY 2, 2007



Application Number 	Application/Control 09/825,537	Applicant(s)/Patent under Reexamination GARAHI ET AL.	
	Richard E. Chilcot	Art Unit 3692	
Document Code - AP.PRE.DEC			

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 09/01/2006.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other: _____

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-34.

Claim(s) withdrawn from consideration: _____

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

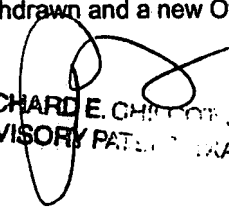
All participants:

(1) Richard E. Chilcot, SPE Art Unit 3692.

(2) Vincent Millin, Appeal Specialist.

(3) _____

(4) _____


RICHARD E. CHILCOT JR.
SUPERVISORY PATENT EXAMINER



EXPRESS MAILING LABEL
NO. EM015926780US

EXHIBIT C:
PRE-APPEAL BRIEF REQUEST FOR REVIEW
FILED SEPTEMBER 1, 2006



ODS-25

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants : Masood Garahi et al.
Application No. : 09/825,537 Confirmation No.: 9788
Filed : April 2, 2001
For : SYSTEMS AND METHODS FOR PLACING PARIMUTUEL
WAGERS ON FUTURE EVENTS
Group Art Unit : 3628
Examiner : Nga B. Nguyen

New York, New York
September 1, 2006

Mail Stop AF
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pursuant to 1296 Off. Gaz. 2 (July 12, 2005) and the January 10, 2006 Extension of the Pilot Pre-Appeal Brief Conference Program, applicants request review of the final rejection of claims 1-34 in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

Arguments begin on page 1 of this Reply.

ARGUMENTS

I. Summary of final Office Action

The Examiner finally rejects claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over Mindes et al. U.S. Patent 5,842,921 (hereinafter "Mindes") in view of Van Horn et al. U.S. Patent 6,631,356 (hereinafter "Van Horn").

II. Summary Of Arguments

For the purposes of this Request, applicants will specify the clear error in the rejections of claims 1-34. Namely, applicants will show that the Examiner's proposed modification of Mindes with the teachings of Van Horn fails to teach each and every element of applicant's claimed invention and that there is insufficient motivation to modify Mindes with the teachings of Van Horn. Applicants reserve the right to present additional arguments subsequent to the decision of the panel review.

III. The Rejection Of Independent Claims 1 And 18

The Examiner rejects claim 1 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Mindes in view of Van Horn. The Examiner's rejection is respectfully traversed.

Independent claims 1 and 18 are directed to a method and system for wagering on a future race using an interactive wagering system. A user is provided with an ability to place a wager in a first parimutuel wagering pool for the future race and is provided with an ability to select a wager type for the wager from a plurality of wager types. A second parimutuel wagering pool is provided for the future race using the interactive wagering system. The second parimutuel wagering pool is separate from the first parimutuel wagering pool whereby odds of the first parimutuel wager pool are calculated using only wagers placed in the first parimutuel wagering pool and odds of the second parimutuel wagering pool are calculated using only wagers placed in the second parimutuel wagering pool. The first and the second parimutuel wagering pools accept wagers of the same selected type and the second parimutuel wagering pool closes after the first parimutuel wagering pool closes.

Mindes refers to a system and method for wagering at fixed handicaps and/or odds on sporting events. Mindes discusses balancing betting pools to minimize the financial exposure of entities that accept wagers. See, e.g., col. 4:12-17. This is accomplished by controlling the terms such as betting odds and/or handicaps for the contestants such that bettors are encouraged to place bets that will bring the betting pools into balance. See, e.g., col. 4:7-17. Mindes' fixed terms betting system is different than a parimutuel system. See col. 2:32-44.

Van Horn is directed to aggregating the demand for products by forming online buying groups. Van Horn states that a buying group "is formed for the specific purpose of purchasing a particular product . . . by defining a start time, end time, critical mass, any minimum number of units offered, any maximum number of units offered, starting price and product cost curve" (Abstract). Van Horn has absolutely nothing to do with wagering or betting.

A. Mindes And Van Horn Fail To Show Or Suggest All The Features Of Applicants' Claimed Invention

It is well-established that "to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" (MPEP § 2143.03). In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, the Examiner's proposed modification of Mindes with the teachings of Van Horn fails to show or suggest at least applicants' claimed features of 1) providing a parimutuel wagering pool and 2) providing first and second parimutuel wagering pools for a future race.

i. Mindes Fails To Show Or Suggest
Providing A Parimutuel Wagering Pool

The Examiner states that Mindes discloses a wagering pool. Applicants' claimed invention, however, requires providing a parimutuel wagering pool. In stark contrast to applicants' claimed invention, Mindes describes a fixed terms betting system. In the background of the invention, Mindes acknowledges that fixed terms betting "is different than the situation in race track betting where a parimutuel system is used" (col. 2:39-40). In fixed terms betting, the odds or handicap of the wager is known at the time it is placed. See col. 2:32-34. In a parimutuel pool, the odds for a wager are only known "after all wagers have been placed" (Mindes, col. 2:43-44). Accordingly, Mindes fails to show or suggest providing a parimutuel wagering pool as required by applicants' claimed invention.

Moreover, Mindes teaches away from parimutuel wagering. Mindes states that "[t]he culture of sports betting is such that the player wants to know the odds or handicap (point spread) of the wager at the time it is placed (fixed terms betting)" (col. 2:32-34).

Accordingly, even if Mindes' fixed terms wagering pools were modified with the teachings of Van Horn as proposed by the Examiner, the combination would fail to show or suggest providing a parimutuel wagering pool as required by applicants' claimed invention. For at least this reason, this rejection should be withdrawn.

ii. Mindes Fails To Show Or Suggest Providing First
And Second Parimutuel Wagering Pools For A Future Race

The Examiner contends that Mindes provides multiple wagering pools for a future race in which a user can place a wager. The Examiner's contention is respectfully traversed.

Mindes states that his system "maintains one or more pools for each event upon which bets are being accepted. Every event has a different pool for each handicap being offered" (col. 8:9-11). Mindes provides basketball as an exemplary sport that uses different handicaps. However, "[t]hose sports which do not use handicaps (baseball, boxing, etc.) are treated as if the handicap were zero so only have one pool" (col. 8:19-21, emphasis added).

Mindes fails to show or suggest that handicaps are used with future races. Accordingly, Mindes also fails to show or suggest providing first and second wagering pools for a future race.

Moreover, Mindes' only mention of races is in his background of the invention. Mindes states that fixed terms betting, which the type of system Mindes describes, "is different

than the situation in race track betting where a parimutuel system is used" (col. 2:39-40). Accordingly, Mindes teaches away from using his alleged invention with future races.

Accordingly, even if Mindes' wagering pools were modified with the teachings of Van Horn as suggested by the Examiner, the combination would fail to show or suggest providing first and second parimutuel wagering pools for a future race as required by applicants' claimed invention. For at least this independent reason, this rejection should be withdrawn.

**B. There Is Insufficient Motivation To Modify
 Mindes With The Teachings Of Van Horn**

The Examiner has failed to provide sufficient motivation for modifying Mindes with the teachings of Van Horn. See *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). See also MPEP §§ 2142 and 2143.01. The Examiner contends that it would be obvious to modify Mindes with the teachings of Van Horn "for the purpose of providing the user with the ability to place a wager in a plurality of wagering pools that have different schedules to open and close" (final Office Action, pp. 3-4).

Van Horn, however, unlike Mindes, has absolutely nothing to do with wagering or betting. Rather, Van Horn is directed to forming buying groups for purchasing products. As explained in Van Horn, a merchant can identify a product to be featured in a buying group and also specifies a minimum and maximum number of units available for sale. See col. 11:8-17. The merchant also specifies a start and end time for the buying group. See col. 11:14. The Examiner has provided no motivation why one skilled in the art would look to the product buying pools of Van Horn to modify the wagering pools of Mindes to include different end times. In Van Horn, a limited number of product units are offered to be sold in a buying group. As long as additional units are available, a merchant can continue to create additional buying groups for that product. This would result in multiple buying groups with different end times. In Mindes, a wagering pool accepts unlimited wagers until some time prior to the completion of a sporting event. However, once that sporting event concludes, the outcome is known and wagers can no longer be placed.

Accordingly, the structure and function of the wagering pools in Mindes and the buying groups of Van Horn are different. Furthermore, Van Horn is not in the field of wagering and the Examiner failed to provide any motivation why one skilled in the art would look to Van Horn to modify the wagering pools of Mindes. Without some objective evidence of a motivation to combine, this obviousness rejection is the "essence of hindsight" reconstruction, the very "syndrome" that the requirement for such evidence is designed to combat, and

insufficient as a matter of law. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999).

Applicants submit that the only suggestion or motivation for modifying Mindes with the teachings of Van Horn is provided by the teachings of applicants' own disclosure. Without a proper motivation for combining the references, the Office Action has "simply take[n] the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. Id.; see also In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002) ("[i]t is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to use that which the inventor taught against its teacher"). Thus, applicants respectfully submit that their own disclosure has been impermissibly relied on in hindsight to see a suggestion in Van Horn that simply is not present.

Therefore, for at least this additional independent reason, this rejection should be withdrawn.

IV. The Rejection Of Dependent Claims 2-17 And 19-34

The Examiner rejects dependent claims 2-17 and 19-34 under 35 U.S.C. § 103(a) as being unpatentable over Mindes in view of Van Horn. The Examiner's rejection is respectfully traversed.

Claims 2-17 and 19-34 depend from independent claims 1 and 18. Applicants request that the rejection of these claims be withdrawn for at least the same reasons why the rejection of independent claims 1 and 18 should be withdrawn.

V. Conclusion

In view of the foregoing, claims 1-34 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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